

REMARKS

Claims 1-11 were presented for examination. All claims were rejected under 35 USC §103 over Shepodd in view of Streitwieser and Morikawa.

With the amendment to Claim 1, Applicant urges that the claimed invention now patentably distinguishes over the prior art (Morikawa).

It is certainly well settled that the prior art must provide some motivation for one of ordinary skill in the art to make the claimed invention as a whole, i.e., select the claimed species from the disclosed prior art genus, to support a conclusion of obviousness. Applicant asserts that such is not the case with Morikawa.

As Applicant has pointed out in an earlier paper, Morikawa explicitly states (col. 12, 26-32) that at hydrogenation pressure below about 1 atm. no sufficient (sic) hydrogenation rate could be obtained. Consequently, one of skill in the art selecting a hydrogen absorbing material would have no motivation for selecting one from the "laundry list" of compounds, including "benzene and its derivatives", disclosed by Morikawa.

Furthermore, since Morikawa requires a hydrogen pressure of greater than 1 atm. for his process, it would be reasonable for one of skill in the art to assume that the materials disclosed by Morikawa could only be hydrogenated, in the presence of a Raney metal catalyst, at pressures greater than 1 atm. However, Applicant has shown, p. 10 Table 2, that the claimed combination of polyphenyl ethers and hydrogenation catalyst can be hydrogenated readily at hydrogen pressures below 1 atm. Thus,

Morikawa cannot have disclosed the claimed polyphenyl ethers, regardless of their structural similarity.

Finally, it is well established that a compound (composition) and its properties are inseparable. As Applicant has shown Morikawa and the claimed composition do not share the same property; the ability of the claimed composition to absorb hydrogen at a pressure of less than one atmosphere. Moreover, the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness. *In re Baird*, 16 F.3d 380, 382 (Fed. Cir. 1992).


Applicants urge that a prima facie case of obviousness has not been made and respectfully request reconsideration and withdrawal of the rejection of claims 1-11.

CONCLUSION

The rejection of claims 1-11 under 35 USC §103(a) having been overcome, Applicant respectfully requests reconsideration and withdrawal of the rejection, and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

Date: 07/09/2003



Donald A. Nissen
Registration No. 44,261
Sandia National Laboratories
P. O. Box 969, MS 9031
Livermore, CA 94551-0969
Telephone (925) 443-7535

Certificate of Mailing Under 37 CFR §1.8

I hereby certify that this Correspondence and documents referred to herein were deposited with the United States Postal Service as first class mail addressed to: Assistant Commissioner of Patents, Washington, D. C. 20231 on the date shown below.

Date of Deposit: 7-18-03

Person making Deposit DORA DA ROSA Signature Dora Da Rosa

Application Number: 10/091,044

For Applicant: Shepodd